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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,523	10/15/2003	Florian Lang	WWELL73.007AUS	5237

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EXAMINER

CARLSON, KAREN C

ART UNIT PAPER NUMBER

1653

DATE MAILED: 11/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/687,523

Applicant(s)

LANG ET AL.

Examiner

Karen Cochrane Carlson, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-29 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

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Claims 1-29 are currently pending and are subject to restriction.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-5, drawn to nucleic acid encoding CICKb, classified in class 536, subclass 23.1.
- II. Claims 6-8, drawn to CICKb, classified in class 530, subclass 350.
- III. Claims 9-11, drawn to a method of diagnosing hypertension via nucleic acid encoding CICKb, classified in class 435, subclass 6.
- IV. Claims 9-11, drawn to a method of diagnosing allergy via nucleic acid encoding CICKb, classified in class 435, subclass 6.
- V. Claims 9-11, drawn to a method of diagnosing hair loss via nucleic acid encoding CICKb, classified in class 435, subclass 6.
- VI. Claims 9-11, drawn to a method of diagnosing infection via nucleic acid encoding CICKb, classified in class 435, subclass 6.
- VII. Claim 9, drawn to a method of diagnosing hypertension via CICKb, classified in class 435, subclass 7.1.
- VIII. Claim 9, drawn to a method of diagnosing allergy via CICKb, classified in class 435, subclass 7.1.
- IX. Claim 9, drawn to a method of diagnosing hair loss via CICKb, classified in class 435, subclass 7.1.
- X. Claim 9, drawn to a method of diagnosing infection via CICKb, classified in class 435, subclass 7.1.
- XI. Claims 12-17, drawn to a method for identifying substances that modulate the activity of CICKb, classified in class 435, subclass 7.1.
- XII. Claims 18- 21, drawn to substances that modulate the activity of CICKb, classified in class 530, subclass 350.

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- XIII. Claims 22-26, drawn to a method of treating hypertension via antisense nucleic acid, classified in class 514, subclass 44.
- XIV. Claims 22-26, drawn to a method of treating allergy via antisense nucleic acid, classified in class 514, subclass 44.
- XV. Claims 22-26, drawn to a method of treating hair loss via antisense nucleic acid, classified in class 514, subclass 44.
- XVI. Claims 22-26, drawn to a method of treating infection via antisense nucleic acid, classified in class 514, subclass 44.

The inventions are distinct, each from the other because of the following reasons:

The nucleic acids of Invention I are related to the protein of Invention II by virtue of encoding same. The DNA molecule has utility for the recombinant production of the protein in a host cell. Although the DNA molecule and protein are related since the DNA encodes the specifically claimed protein, they are distinct inventions because the protein product can be made by another and materially different process, such as by synthetic peptide synthesis or purification from the natural source. Further, the DNA may be used for processes other than the production of the protein, such as nucleic acid hybridization assay.

The nucleic acid of Invention I and the polypeptide of Invention II differ in structure and function from the substance of Invention XII. Therefore, Inventions I and II are patentably distinct from Invention XII.

Inventions I and Inventions III, IV, VI, and VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a

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materially different process such as in any one of the methods of Inventions III, IV, VI, and VI, or to recombinantly produce polypeptide.

The product of Invention I is not used in the methods of Inventions VII, VIII, IX, X, XI, XIII, XIV, XV, or XVI. Therefore, Invention I is patentably distinct from Inventions VII, VIII, IX, X, XI, XIII, XIV, XV, or XVI.

Invention II and Inventions VII, VIII, IX, X, and XI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process such as in any one of the methods of Inventions VII, VIII, IX, X, or XI, or to produce antibodies.

The product of Invention II is not used in the methods of Inventions III, IV, V, VI, XIII, XIV, XV, or XVI. Therefore, Invention II is patentably distinct from Inventions III, IV, V, VI, XIII, XIV, XV, and XVI.

Invention XII and Invention XI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process such as to produce antibodies.

The product of Invention XII is not used in the methods of Inventions III, IV, V, VI, VII, VIII, IX, X, XIII, XIV, XV, or XVI. Therefore, Invention XII is patentably distinct from Inventions III, IV, V, VI, VII, VIII, IX, X, XIII, XIV, XV, and XVI.

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The methods of Inventions III, IV, V, VI, VII, VIII, IX, X, XI, XIII, XIV, XV, and XVI require different products and steps and have different endpoints. Therefore, Inventions III, IV, V, VI, VII, VIII, IX, X, XI, XIII, XIV, XV, and XVI are patentably distinct.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

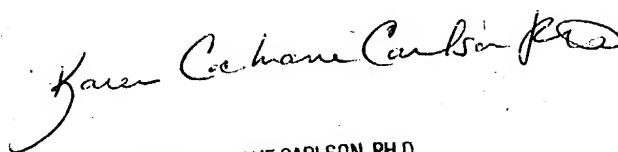
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen Cochrane Carlson, Ph.D. whose telephone number is 571-272-0946.

The examiner can normally be reached on 7:00 AM - 4:00 PM, off alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Jon Weber can be reached on 571-272-0925. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



KAREN COCHRANE CARLSON, PH.D.
PRIMARY EXAMINER